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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Evan Sundquist  
Serial Number: 09/762,781  
Filed: 02/13/2001  
For: Sheet Wiper  
Group Art Unit: 1772  
Examiner: Nordmeyer, Patricia L.

## REPLY BRIEF

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

In response to the Examiner's Answer mailed April 19, Appellant hereby submits a permissive reply pursuant to 37 CFR § 1.193.

Obviousness Over Jones Sr.:

The Appellant has previously noted that the modification of the applicator in Jones Sr. proposed by the Examiner to support the rejection would fundamentally change the construction and function of the prior art device. In particular, if the applicator of Jones Sr. were modified in the manner proposed by the Examiner the discrete applicator leaves (19) would not be formed within the stacked layers. This would greatly reduce the effective surface area for agent application. In addition, the proposed elimination of the handle would force the user to grasp the

body of the applicator which will be saturated with the agent to be applied such as shoe polish, soap or the like. The Examiner's Answer states that one of ordinary skill in the art would recognize that the handle is an unnecessary addition. However, no support is provided for this position. Moreover, the Examiner's Answer fails to address the fact that the proposed modification would eliminate the discrete applicator leaves advocated by the cited art.

As best understood, the modification proposed by the Examiner would yield a stacked arrangement of sheet elements with continuous border edges and no handle. Such a construction would clearly function in a manner quite different from the handled structure with discrete applicator leaves taught by the cited reference. In particular, independent movement of leaf elements around the perimeter would be prevented. In addition, the saturated portion of the applicator would have to be grasped directly by a user giving rise to the possibility of hand staining and other contamination issues.

In response to the arguments pointing out that the proposed alteration of the prior art would fundamentally change the prior art, the Examiner's Answer cites MPEP §2183 and states that the prior art element performs the function in substantially the same manner as the wiper disclosed in the specification. Such arguments appear to be irrelevant. Appellant respectfully notes that functional equivalence between the present claim and the prior art is not an issue in the present case since there is no means-plus-function limitation in the claims. Rather, the issue is whether or not there would be motivation to modify the prior art in the manner proposed by the Examiner. In light of the fact that the proposed modification would detract from the performance of the cited art article, Appellant respectfully submits that such motivation would be lacking.

#### Obviousness over Morin et al.:

The Examiner's Answer states that:

*One of ordinary skill in the art would have recognized that the gained advantages by the hexagonal shape, shorter perimeter edges while having a greater interior surface area which leads to less contamination, since one of ordinary skill could use known general geometry formulas to compare surface areas to edge perimeter; thereby, giving one of ordinary skill in the art the*

*ability to determine the optimum shape to get a greater surface area with less contamination from particulate matter, be it a hexagon or square.*

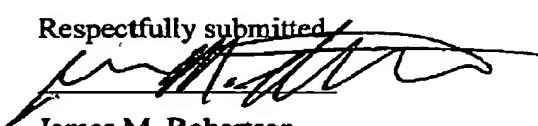
Appellant respectfully submits that the Examiner's rational ignores the fact that the cited reference to Morin is directed specifically at practices to reduce particle contamination yet still states that a square geometry is most preferred. This indicates that the use of a controlled shape such as the presently claimed hexagonal shape was not recognized as being beneficial for particle reduction prior to the present invention.

As stated at MPEP §2141.02, obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established. Appellant respectfully submits that Morin's failure to in any way recognize a correlation between perimeter length and particle generation reflects a lack of appreciation for this relationship by those of skill in the art prior to the present invention. This is particularly significant since Morin is focused on reducing particles. Moreover, in order to adopt a hexagonal geometry one is required to specifically ignore the teachings in Morin that square geometries are preferred. It is respectfully submitted that such circumstances are strong evidence of non-obviousness.

### CONCLUSION

For the reasons set forth above, Appellant respectfully contends that the cited art relied upon by the Examiner is insufficient to support rejection of the claims. Authorization is hereby provided to charge any fee required for acceptance of this paper to deposit account 50-1424.

Respectfully submitted

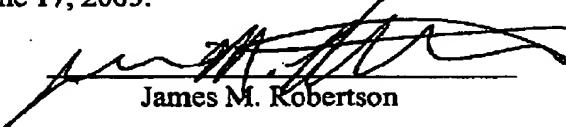


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Date: June 17, 2005

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted to The United States Patent and Trademark Office at 703-872-9306 on June 17, 2005.

  
James M. Robertson